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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/573,214

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EXAMINER

TREYGER, ILYA Y

ART UNIT

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02/10/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/573,214	Applicant(s) NANJYO ET AL.	
	Examiner ILYA Y. TREYGER	Art Unit 3761	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 March 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on _____ is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 1-5 are amended.
2. Claims 6-20 are new.
3. The PCT/JP04/14389 received among the documents of the instant Application has been acknowledged.
4. Claims 1-20 are examined on the merits.

Response to Arguments

5. Applicant's arguments filed 10/09/2008 have been fully considered but they are not persuasive:
6. With respect to claim 1, Applicants argue that Shimoe does not anticipate the claimed invention because the reference does not provide a distinct middle height portion of the absorbent body.

However, the distinct middle height portion is not required by the claim. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

In addition, any curve can be considered as the limit of a sum of elements (distinct steps) when the number of such elements increases without bound while the size of the elements diminishes (See *The Columbia Electronic Encyclopedia*®). Consequently, any curved shape can be considered as composed of distinct elements (steps), and therefore, it would have been obvious to those skilled in the art at the time the invention was made to use the steps-shape of the absorbent core as an obvious design choice, and as such it does not impact the patentability of claim.

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Nevertheless, the second reference JP 2003230593 has been brought in support to the obviousness rejection (See the Rejection below).

7. Applicants further argue that Shimoe does not anticipate the claimed invention because does not disclose the leakage preventing grooves side walls of equal depth, which provide for better leakage prevention than the configuration of the Shimoe reference.

However, the level of leakage prevention straightly depends of the groove liquid capacity, wherein the liquid capacity of the groove can never be defined by the fact of equality of the groove side walls, but by the depth of the smaller wall only. Since the smaller wall of Shimoe's grooves is fully capable of providing the desired level of the groove liquid capacity, the grooves with the walls of equal depth is the matter of an obvious design choice, and as such it does not impact the patentability of the claim. Nevertheless, the second reference JP 2003230593 has been brought in support to the obviousness rejection (See the Rejection below).

Claim Rejections - 35 USC § 112

8. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

9. Claims 1-20 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. In the instant case the newly introduced limitations of "opposing outer absorbent

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body edges", "a middle-height portion layered over said standard height portion", side edge steps", and "side walls of the leakage preventing grooves equal on opposing sides of said leakage preventing grooves" are not supported by the Applicant's specification.

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

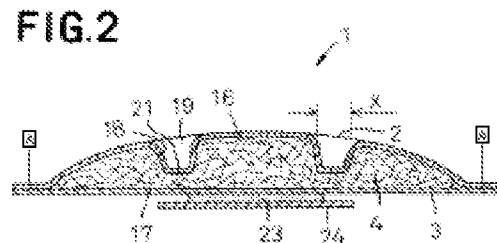
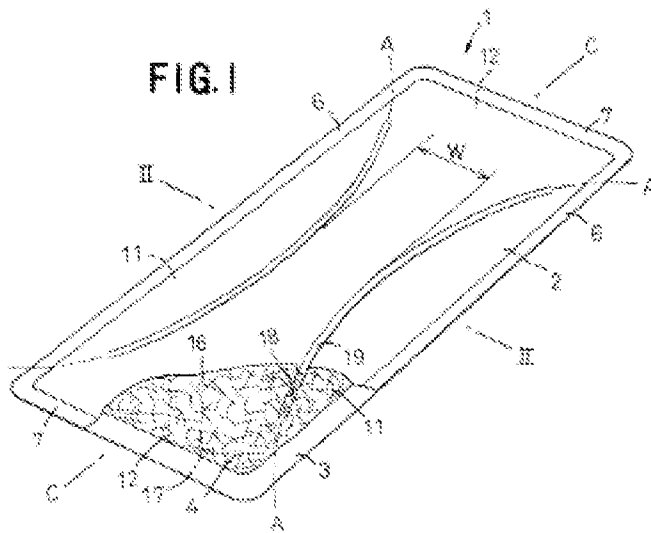
12. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

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13. Claims 1-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shimoe et al. (US 6,867,345) in view of JP 2003230593.

14. In Re claims 1-4, 6, 10, 14, and 18, Shimoe discloses the sanitary napkin (absorbent article) 1 (Figs. 1 and 2) comprising a liquid-pervious topsheet 2 (Figs. 1 and 2), a liquid-impervious backsheet 3 (Figs. 1 and 2) and a liquid-absorbent core 4 (Figs. 1 and 2) disposed between the topsheet 2 and the backsheet 3 (Col. 3, ln. 3-6); the topsheet 2 is formed with a pair of second grooves (leakage preventing grooves) 19 depressed and curved in coincidence with the first grooves 18 (Col. 3, ln. 21-24; Figs. 1 and 2); wherein the leakage preventing grooves 19 (Fig. 2) are deeper than a thickness of the middle-height portion and reach the standard portion absorbent body (See Fig. 2); wherein the thinned portion A (Fig. 2) obtained by thinning the middle-height portion by press is formed on outsides of the leakage preventing grooves 19 (Fig. 2); wherein the middle-height portion is formed between front and rear lines W (Fig. 1) fully capable to be a folding lines for folding the absorbent article in three at the time of individual packaging; and wherein the thickness of the middle-height portion absorbent body is 1 to 15 mm (Col. 3, ln. 35, 36), what encompasses 1-3 mm as claimed (claims 6, 10, 14, and 18).

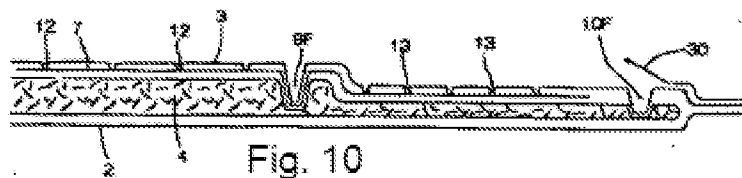
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Shimoe does not expressly disclose the absorbent article, comprising the absorbent body having opposing outer absorbent body edges extending in a longitudinal direction of the absorbent body; having a middle-height portion layered over the standard height portion, wherein the middle-height portion is in the form of the distinct step, and wherein the leakage preventing grooves comprise side walls equal in height.

JP 2003230593 teaches the absorbent article comprising the absorbent body having opposing outer absorbent body edges extending in a longitudinal direction of the absorbent body; having a middle-height portion layered over the standard height portion, wherein the middle-height portion is in the form of the distinct step, and wherein the leakage preventing grooves comprise side walls equal in height.

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It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the absorbent body of Shimoe with the design, as taught by JP 2003230593 in order to employ the conventionally known variation of the absorbent body design.

15. In Re claims 5 and 13, Shimoe in view of JP 2003230593 disclose the invention discussed above, but do not expressly disclose the particular parameter of the absorbent body standard-height portion thickness range.

The particular parameter of the of the absorbent body standard-height portion thickness range depends of the absorbent material has been used and affects the level of compactness while the article is being folded, and therefore is the matter of optimization as being result effective variable. It would have been obvious to one having ordinary skill in the art at the time the invention was made to use the claimed parameter of the of the absorbent body standard-height portion thickness range in order to reach the desired level of compactness, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. *In re Aller*, 105 USPQ 233(MPEP 2144.05 (II-A)).

16. In Re claims 7-9, 11, 12, 15-17, 19, and 20, Shimoe in view of JP 2003230593 disclose the invention discussed above, but do not expressly disclose the particular parameter of the leakage preventing grooves dimensions range.

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The particular parameter of the leakage preventing grooves dimensions range affects the liquid capacity of the grooves and therefore is the matter of optimization as being result effective variable. It would have been obvious to one having ordinary skill in the art at the time the invention was made to use the claimed parameter of the leakage preventing grooves dimensions range in order to reach desired liquid capacity of the grooves, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. *In re Aller*, 105 USPQ 233(MPEP 2144.05 (II-A)).

Conclusion

17. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to ILYA Y. TREYGER whose telephone number is (571)270-3217. The examiner can normally be reached on 7:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tatyana Zalukaeva can be reached on 571-272-1115. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Ilya Y Treyger/
Examiner, Art Unit 3761

/Michele Kidwell/
Primary Examiner, Art Unit 3761